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WOODS FULLER

011/014

Appln. No. 10/625,252
Amendment dated November 26, 2008
Reply to Office Action mailed October 15, 2008

REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claims 1, 3, 5 through 7, 9 through 13 and 15 through 23 remain in this application. Claims 2, 4, 8, 14 and 24 have been cancelled. No claims have been withdrawn. No claims have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 1 of the Office Action

Claims 10 and 16 have been objected to for the informalities noted in the Office Action.

Claims 10 and 16 have been amended in a manner believed to clarify any informalities in the language. Specifically, claim 10 has been amended to depend from claim 7 and claim 16 has been amended to depend from claim 13.

Withdrawal of the objection to claims 10 and 16 is therefore respectfully requested.

Paragraph 2 of the Office Action

Claims 1, 3, 5 through 7, 9 through 13, 15 through 20 and 21 through 23 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Roth and Kiely in view of Katz.

Claim 1, particularly as amended, requires "including, by the seller during the occurrence of the sales transaction, the real-time marketing

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opportunity corresponding to the winning bid, *the real-time marketing opportunity including an offer made to the customer to be included in the sales transaction if accepted*", "permitting the customer to take advantage of the one or more marketing opportunities as a part of the sales transaction prior to the sales transaction for the product of the seller being completed", and "completing the sales transaction between the seller and the customer for the product, and if the customer takes advantage of the offer of the real-time marketing opportunity, processing the offer of the real-time marketing opportunity in the sales transaction" (all emphasis added).

Claims 7 and 13 includes similar but not identical requirements.

It is submitted that, even if one were to assume for the purpose of argument only that the characterizations of the Roth, Kiely, and Katz documents in the rejection are correct, that the allegedly obvious combination would not lead one of ordinary skill in the art to the requirements of the claims as amended, particularly the requirement that "the real-time marketing opportunity including an offer made to the customer to be included in the sales transaction if accepted".

It is contended in the Response to Arguments" portion of the Office Action that:

Applicant argues that the combination of Roth, Kiely, and Katz (specifically Katz) does not disclose taking advantage of a real time marketing opportunity as part of the primary order (as recited in claim 1) for the product by pointing to specific embodiments (figure 7) of Katz. The examiner disagrees as figure 6 clearly shows a customer taking advantage of an upsell (i.e. marketing opportunity) as part (emphasis added) of the primary order. Paragraph 102 expands upon the primary transaction block 300 (which applicant argues separates the upsell offer from the primary transaction):

[0102] Credit data 332 may be checked in the course of the primary transaction, as well as in the course of generating inputs or processing for the upsell determination. In one aspect, the credit verification may take place in conjunction with a credit verification for the primary transaction. If the primary transaction is a purchase transaction, the credit verification may

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be obtained for the primary transaction, and then either obtain a specific credit authorization for an amount equal to the expected upsell, or obtain an indication of the amount of available credit remaining. If the amount of available credit remaining is provided, that will provide an indication of the preferably upper bound on the cost of the upsell offer.

Therefore the primary transaction of Katz is not necessarily a purchase transaction (i.e. sales transaction) and the upsell opportunity (blocks 310 and 350) occur before consummation of the primary order fulfillment block 360 including billing (i.e. sales transaction).

However, it is submitted that none of the cited documents, either alone or in combination, disclose the requirements of "determining an occurrence of the sales transaction including the primary order for the product of the seller" as well as "including, by the seller during the occurrence of the sales transaction, the real-time marketing opportunity corresponding to the winning bid, the real-time marketing opportunity including an offer made to the customer to be included in the sales transaction if accepted" and "permitting the customer to take advantage of the one or more marketing opportunities as a part of the sales transaction prior to the sales transaction for the product of the seller being completed", all in the context of the requirements of offering the sales opportunity to third parties in the manner claimed. The line of argument in the Remarks appears to rely upon a situation where the initial contact with the customer is not a "sales transaction" in order to meet the requirements of the claim, but in that case the offer of the real-time marketing opportunity is not being offered "during the occurrence of the sales transaction" and is not an "offer made to the customer to be include din the sales transaction", since it appears to be conceded in the Remarks that the requirements are not met unless "the primary transaction of Katz is not [] a purchase transaction".

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Roth, Kiely and Katz set forth in the rejection of the Office Action, would not lead one skilled in the art to the

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applicant's invention as required by claims 1, 7 and 13, as well as the claims that depend from claims 1, 7, and 13, which also include the requirements of claims 1, 7, and 13.

Withdrawal of the §103(a) rejection of claims 1, 3, 5 through 7, 9 through 13, 15 through 20 and 21 through 23 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.



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